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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

555255-012416

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on Dec. 12, 2005Signature Debra L. PejeauTyped or printed name Debra L. Pejeau

Application Number

10/663,582

Filed

09/16/2003

First Named Inventor

Michael Knowles

Art Unit

2681

Examiner

Erika Gary

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 47,919

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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12/12/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 555255012416

Group Art Unit: 2681 )  
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Examiner: Erika Gary )  
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Inventor: Michael Knowles )  
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Serial No.: 10/663,582 )  
)  
Filed: September 16, 2003 )  
)  
For: Demand-Based Provisioning For )  
A Mobile Communication Device )

**PRE-APPEAL BRIEF  
CONFERENCE REQUEST**

**CERTIFICATE OF MAILING**

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By Debra L. Geyan

Sir:

The Examiner has finally rejected claims 1, 2, and 4-11 as being unpatentable. The rejections of claims 1, 2, and 4-11 are now appealed. The Applicant hereby requests review of the final rejection prior to filing an appeal brief for the reasons set forth below. The Applicant submits that the Final Rejection contains clear errors in fact, and the limitations of the claims are clearly not met by the cited references.

## **CLEAR ERROR IN FACT**

The claims in the above application relate to minimizing bandwidth and other resources that are used to update or provision mobile devices. In particular, preventing repeat transmissions of updates is a primary focus of the claims. The cited reference, Yang, does not guard against repeating previous transmissions, Yang only locates the program for downloading or unlocking. Furthermore, Yang discloses a process for provisioning that requires extra steps and would require more resources and bandwidth than the claimed techniques. After reviewing the Final Office Action, Applicants assert that a clear error in fact has been made with regard to the Yang reference's alleged disclosure of the claim 1 limitations: "determine if the stored service information has previously been transmitted to the mobile communication device;" (hereinafter, the "claimed determination") and "if the stored service information has not previously been transmitted to the mobile communication device, then ... transmit the service update message to the mobile communication device."

In the Response to Arguments section of the Final Office Action, the Examiner defends her assertion that Yang discloses the claimed determination by pointing to paragraphs [0045] to [0046] of Yang. These paragraphs, however, describe a search "to confirm the existence and location of the requested application program(s)." The search may also determine if the "requested application program already resides in a memory of the mobile device 110, but is not presently accessible by the user because it is not yet activated." Then "[i]f the search confirms the existence and location of the requested application program(s), the call center sends a message to the mobile device of the requestor containing a file retrieve command." As explained below, the search of Yang is far different in manner of operation, retrieved information, and resulting benefits than the claimed determination.

The Yang search and the technology described in the claims of the instant application operate very differently and retrieve different results. In Yang, the call center performs the search by searching a database or some other source that contains information that will confirm the existence and location of the requested application program(s). (See paragraphs [0045] and [0046].) Thus, it would search and retrieve the program itself. In contrast, the claims of the instant application recite determining if information has been previously transmitted. This claimed process may include, for example, a search of a log of transmissions, and may retrieve a log entry for the transmission of the requested program, but it would not involve a search for the existence and location of the actual program.

There are different resulting benefits and detriments to these two different types of searches. The search of Yang does not detect if a program has already been transmitted, therefore the claim limitation "if the stored service information has not previously been transmitted to the mobile communication device, then ... transmit the service update message to the mobile communication device" cannot be performed by Yang. Because Yang fails to perform this step, it would allow the same program to be transmitted multiple times. This is detrimental because more bandwidth and other resources will be used when efforts are duplicated. In contrast, the technology set forth in the claims will minimize the bandwidth and system resources that are used and will prevent duplication of effort.

The above arguments are clearly illustrated by comparing the claims to Fig. 2 of Yang. In Yang, note that the box 230 and the diamond beneath it represent the search of Yang and what happens next according to the results of the search. The Examiner alleges that these elements read on the claimed determination. It can readily be seen that the claimed determination: "determine if the stored service information has previously been transmitted to the mobile

communication device" is not the same as "program found?" in Yang. Finding the program is different from determining whether it has been previously transmitted. Yang's teaching is limited to determining if a program is available or not irrespective of any transmission information. Furthermore, Yang does not teach what to do with a positive or negative determination of whether the program has been previously transmitted, as opposed to the claims that state "if the stored service information has not previously been transmitted to the mobile communication device, then ... transmit the service update message to the mobile communication device." It is clear that Yang does not teach a systematic service information encapsulation and transmission to a mobile device in the event the service information has not been transmitted.

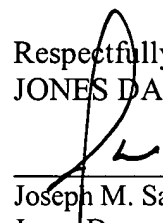
In addition, Applicants also maintain that the Examiner has not shown the limitation of "encapsulat[ing] the service information in a service update data message and transmit[ting] the service update data message to the mobile communication device" is anticipated, and the Examiner's assertion that this limitation is shown in the cited portions of Yang (paragraphs [0041]-[0047] and [0051], [0053]) is clearly factually incorrect.

While it may be true, as the Examiner alleges, that Yang sends a command to the mobile device to initiate retrieval of the service update information, this is not the same as the claimed "transmit[ting] the service update data message to the mobile communication device." In Yang, the message sent to initiate retrieval contains a file retrieval command, which "either (i) prompts file server 150 to download the application program(s) to mobile device 110 (260) or (ii) activates the application program stored in the mobile device memory." (See paragraph [0046].) The claimed "encapsulat[ing] the service information in a service update data message and transmit[ting] the service update data message to the mobile communication device," does not

initiate retrieval in the mobile device; it is a transmission of the requested program itself. Yang's sending a message to prompt the server to download the application or activating the application stored in memory is not a direct transmission of the actual program. Therefore, the claimed limitation imparts the advantage of eliminating this file retrieval message step, because the program is directly sent to the mobile device with no additional steps. This saves bandwidth and other resources.

In summary, Yang does not guard against repeating previous transmissions, as claim 1 provides for, Yang only locates the program for downloading or unlocking. Applicants contend that independent claim 1 is in condition for allowance, and by virtue of their dependence on claim 1, the remaining claims 2 and 4-11 are also in condition for allowance.

Respectfully submitted,  
JONES DAY



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